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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 14.

Application Number: 08/274,942

Filing Date: 07/14/94

Appellant(s): Peter Hagmann, et al

Michael W. Glynn Ciba-Geigy Corp.
For Appellant

DEC 19 1996

GROUP 1300

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed September 16, 1996.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

Art Unit: 1307

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) ***Summary of Invention***

The summary of invention contained in the brief is correct.

(6) ***Issues***

The appellant's statement of the issues in the brief is correct.

(7) ***Grouping of Claims***

The brief includes a statement that all of the pending class stand or fall together, such statement agreed with.

(8) ***ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) ***Prior Art of Record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,113,224

CLARK et al.

9-1978

484,015

FOGARTY (European)

5-1992

(10) ***New Prior Art***

No new prior art has been applied in this examiner's answer.

Art Unit: 1307

(11) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 8-40, 42-61 and 63-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al.

Clark et al discloses the basic method and apparatus for manufacturing moldings that are crosslinked in a mold including a step and means of curing the lens material with energy (col. 6, line 51) wherein the filling of the mold cavity is carried out "in the starting material". Clark et al provides a reservoir which surrounds the mold cavity in which starting material is contained and it is submitted that his reservoir has starting material which "floods" the mold cavity, as the amount contained therein is in excess of that required to fill the cavity. In fact, the excess is at least as great as the amount required to flow back into the cavity during the curing to compensate for the shrinkage. See column 7, lines 59-64. The molds are closed "in the starting material", female mold member 15 constitutes a container having a female molding surface (41), and the male mold (13) is displaceable. It is submitted that the mold arrangement shown in Clark et al is at least readable on instant claim 52 and the method of using it in claim 17. Concerning the mask, see 141 in Fig. 3; concerning the spacers, see 131 in Fig. 3. For the parallel beam of radiation, see col. 7, line 28.

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A monomeric material is one that is "crosslinkable" and that is "in a state in which it is at least partially uncrosslinked" when introduced into the mold as set forth in the instant claims. In the process of Clark et al, it is submitted that the edge contour of the molding is determined substantially by the energy impingement; to produce the molding in Clark et al with no burr or flash would have been obvious if desiring to do so. Note column 7, lines 46-55, wherein it is taught that polymerization of the material in the reservoir is merely a preferred embodiment, to facilitate further handling. One of ordinary skill, not requiring same, would have found polymerizing only the lens portion (ie, not polymerizing the material in the reservoir in a second step) to be entirely obvious dependent on subsequent handling for the lens.

Clark et al. lacks a disclosure of pumps to feed in the material and either a gripper or flushing out of the mold cavity to remove the lens. Clark et al teaches depositing the material into the cavity (col. 4, line 23) and a pump would facilitate such a deposition. Grippers to remove products are nothing but conventional in the art and would have been an obvious feature in Clark et al to remove the lens. Likewise, using a flow of fresh starting material between the molds of Clark et al to remove the cured lines is submitted as obvious to one of ordinary skill in the art in that such would facilitate the subsequent loading. The aspect of providing the male mold on the container (instead of the female mold as taught in Clark et al) is submitted as obvious dependent on relative location of the mold pieces desired. Such merely involves a rearrangement of the parts of Clark et al. The exact materials used as set

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forth in instant claims 30-38 would have been obvious material selections to one of ordinary skill in the art in the process of the applied reference dependent on the exact properties desire for the lens. Note that Clark et al places the mask externally to the mold halves. It would have been entirely obvious to one of ordinary skill in the art at the time of invention to have placed the mask on the mold halves (ie, between the parting line/separating plane of the mold halves) as such merely constitutes a rearrangement of parts that would have been within the skill level of the art. Washing the mold halves with a solvent to remove any traces of starting materials before commencing another molding cycle as set forth in instant claim 11 is nothing but conventional in the art and would have been an obvious feature in Clark et al by one of ordinary skill in the art to prevent contamination. Likewise, the limitation of instant claim 39 is nothing but conventional and would have been obvious to facilitate the additional handling (such as hydration or sterilization) required prior to shipping the lens.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al in view of European Patent Application 484,015.

Clark et al. has been discussed supra and discloses the basic claimed method lacking essentially using a mold made of parts that have different permeabilities to the crosslinking energy. European - -015 teaches this (page 5, lines 16-26). It would have been obvious to one of ordinary skill in the art at the time of invention to have utilized a mold as taught by European -015 in the process of Clark et al to further ensure that the starting material around the mold cavity remains flowable (uncured).

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(12) *New Ground of Rejection*

This examiner's answer does not contain any new ground of rejection.

(13) *Response to argument*

Appellant argues that a prime facie case of obviousness has not been made. This is not agreed with. The reason that the Clark et al process would be modified by one of ordinary skill in the art is found at column 7, lines 46-55 of Clark et al. Ie, "for convenience in later handling" (attachment of the lens to the female mold for a subsequent deflashing, see col. 8, lines 53-58), it is preferred that the uncured material in the reservoir and the restriction be polymerized. While admittedly the reference discloses a subsequent flash removal step, clearly this step wold be required, having performed the preferred step, to make a useful lens. However, if one did not perform the preferred step, then the adjustable diaphragm would be opened to a position adjacent "to the edge of the mold" (col. 7, lines 21-26) and only the material necessary to make the lens would be polymerized.

Appellant argues that there is no suggestion or recognition in Clark et al that the two-step polymerizing process can be modified for any reason. This is not persuasive. See In re Miller, 94 USPQ 88, which states:

"The omission of an element or a step in a process, with a corresponding omission of the function thereof does not as a rule constitute invention. However, the omission of such an element or step which results in a wholly different structure or process and a great and unexpected advance in the art is recognized by the courts as patentable subject matter."

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It is submitted that the instant omission does not result in a wholly different process nor a great and unexpected advance in the art. One of ordinary skill in the art would have expected that a lens of some utility would be made having eliminated the second polymerization step and subsequent deflashing in Clark et al. There is no evidence of record indicating that lenses made by the instant one-step molding process and apparatus are unexpectedly better than those made by the preferred, two-step molding process and apparatus disclosed in Clark et al.

Comments directed to European -015 are unnecessary as claim 5 stands or falls with claim 1.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

M. Vargot/om
December 10, 1996
December 13, 1996
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